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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Scott CARRIER	:	Confirmation Number: 9171
	:	
Application No.: 10/712,544	:	Group Art Unit: 2178
	:	
Filed: November 13, 2003	:	Examiner: M. Patel
	:	
For: LIGHTWEIGHT FORM PATTERN VALIDATION	:	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed April 25, 2008, wherein Appellant appeals from the Examiner's rejection of claims 1, 6, 11, and 15.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on November 13, 2003, at Reel 014707, Frame 0146.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1, 6, 11, and 15 are pending and five-times rejected in this Application. It is from the multiple rejections of claims 1, 6, 11, and 15 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Fifth Office Action dated January 25, 2008 (hereinafter the Fifth Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figures 1 and 2 and also to independent claim 1, a lightweight pattern validation system for a client device 130 receiving markup 200 defining a form 160 is disclosed (paragraph [0017] of Appellant's disclosure). The system includes a validation processor 150 and a validation script library 140 (paragraph [0018]). The validation processor 140 is separate from the markup 200 and configured with a prototype interface for receiving both a field validation pattern 170 and also form based input 170 to be validated against the field validation pattern 170 (paragraph [0018]). The validation script library 140 is within the client device 130 and packages the validation processor 150 (paragraph [0018]). The form 160 has at least one form based input field programmed for validation using the validation processor 150 (paragraph [0019]). A library reference 210 to the script library 140 is disposed in the markup 200 (lines 1-2 of paragraph [0021]). A function call 240 to the validation processor 150 is further disposed in the markup 200, and the function call 240 is configured to pass a reference to a value in the at least one form based input field for validation in the validation processor 150 (lines 1-5 of paragraph [0022]). A plurality of additional function calls to the validation processor 150 are

disposed in the markup 200, and each additional one of the functional calls having a configuration for passing a reference to a value in a corresponding form based input field for validation in the validation processor 150 (lines 3-6 of paragraph [0020]). A validation shell function 220 encapsulates the function calls 240 (lines 1-3 of paragraph [0022]; lines 5-9 of paragraph [0023]).

Referring to Figure 3 and also to independent claim 6, a pattern validation method is disclosed. In block 310, a value for a form based input field is retrieved from a form defined in markup rendered in a content browser (paragraph [0023]). In block 330, the retrieved value along with a validation pattern for the form based input field is passed to a validation process disposed within a lightweight validation library separate from and coupled to the rendered markup (paragraph [0023]). In block 350, the retrieved value is validated according to the validation pattern in the content browser (paragraph [0024]). In block 370, the retrieving, passing and validating steps are repeated for at least one additional value for at least one additional form based input field disposed in the markup rendered in the content browser (lines 8-10 of paragraph [0024]). The retrieving, passing, validating and repeating steps are performed in a validation shell function disposed in the markup rendered in the content browser (lines 1-3 of paragraph [0022]; lines 5-9 of paragraph [0023]; lines 4-5 of paragraph [0024]).

Referring to Figure 3 and also to independent claim 11, a machine readable storage having stored thereon a computer program for pattern validation is disclosed. The computer program comprises a routine set of instructions which when executed by the machine cause the machine to perform the following steps. In block 310, a value for a form based input field is retrieved from a form defined in markup rendered in a content browser (paragraph [0023]). In block 330, the retrieved value along with a validation pattern for the form based input field is

passed to a validation process disposed within a lightweight validation library separate from and coupled to the rendered markup (paragraph [0023]). In block 350, the retrieved value is validated according to the validation pattern in the content browser (paragraph [0024]). In block 370, the retrieving, passing and validating steps are repeated for at least one additional value for at least one additional form based input field disposed in the markup rendered in the content browser (lines 8-10 of paragraph [0024]). The retrieving, passing, validating and repeating steps are performed in a validation shell function disposed in the markup rendered in the content browser (lines 1-3 of paragraph [0022]; lines 5-9 of paragraph [0023]; lines 4-5 of paragraph [0024]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claim 1 was rejected 35 U.S.C. § 101; and
2. Claims 1, 6, 11, and 15 were rejected under 35 U.S.C. § 103 for obviousness based upon Dziejma, U.S. Patent Publication No. 2005/0028084, in view of Sokolov, U.S. Patent No. 6,823,504.

VII. ARGUMENT

THE REJECTIONS OF CLAIM 1 UNDER 35 U.S.C. § 101

For convenience of the Honorable Board in addressing the rejections, claim 1 stands or falls alone.

In the paragraph spanning pages 2 and 3 of the Fourth Office Action, the Examiner asserted the following:

Regarding independent claim 1, the claim describes a system but fails to include any hardware elements in the system such as a CPU. Instead the claims describe the use of a system for a client device, it is unclear since the system is merely steps that may be used by a device only if it was embodied in a computer readable medium. If the system is directed to software it should be embodied inside a computer readable medium, if for hardware it should recite a hardware element in the claims such as a processor. A validation processor is not an actual hardware element. Furthermore a system that can be used for client devices is not sufficient because the system itself is not tangibly embodied in a computer readable medium to be used by anything. Appropriate corrections are required.

Appellant respectfully submit that the Examiner's analysis is fatally flawed. Specifically, the Examiner is directed to the recent decision of the Federal Circuit of In re Comiskey.¹ Although the Court held that several claims were directed to non-statutory subject matter, the Court determined that certain other of the claims were directed to statutory subject matter. In determining the latter, the Court stated the following:

These claims, under the broadest reasonable interpretation, could require the use of a computer as part of Comiskey's arbitration system. (emphasis added)

Thus, the Court determined that the claims are not required to necessarily include or require a computer. Instead, the Court concluded that the claims meet the requirements of 35 U.S.C. § 101 if, under a broadest reasonable interpretation, the claims could require the use of statutory subject matter (e.g., a computer, a device, a product, etc.). As is readily apparent from

¹ Appeal No. 2006-1286.

Appellant's disclosure, a validation processor could require the use of a computer device. Thus, the claimed invention is directed to statutory subject matter.

The Examiner's response to Appellant's arguments are found in the second full paragraph on page 6 of the Fifth Office Action and reproduced below:

The Examiner Respectfully Disagrees: The Examiner is unaware of any FATAL consequences resulting from the 35 U.S.C. 101 rejections in this or any patent application.. The recited court decision and statement describing that the validation processor could require the use of a computer device does not address the 35 U.S.C. 101 rejection, because the issue is not whether the validation processor can be used by a device, the issue is that the validation system itself is not tangibly embodied in a computer readable medium and thus could not possibly be used by any device computer or otherwise.
(emphasis in original)

Appellant will ignore the Examiner's first statement as an inappropriate attempt at humor. The remainder of the Examiner's analysis does not reflect a proper understanding of the law.

Claim 1 recites a system, and as noted in paragraph [0025] of Appellant's disclosure, the present invention can be realized in hardware and, specifically, a computer system. Thus, given the broadest reasonable interpretation of the claims consistent with Appellant's disclosure, the claimed system could be directed to a computer/hardware system, which is statutory subject matter. Therefore, claim 1 is directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

**THE REJECTION OF CLAIMS 1, 6, 11, AND 15 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON DZIEJMA IN VIEW OF SOKOLOV**

For convenience of the Honorable Board in addressing the rejections, claims 6 and 11 stand or fall together with independent claim 1, and claim 15 stands or falls alone.

As is evident from Appellant's previously-presented comments during prosecution of the present Application and from Appellant's comments below, there are questions as to how the limitations in the claims correspond to features in the applied prior art. In this regard, reference is made to M.P.E.P. § 1207.02, entitled "Contents of Examiner's Answer." Specifically, the following is stated:

(A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

...

(9)(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate. (emphasis added)

Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner's Answer, the Examiner is required to include the aforementioned section in the Examiner's Answer.

Appellant has compared the statement of the rejection found on pages 2-6 of the Fifth Office Action with the statement of the rejection found on pages 3-12 of the Fourth Office Action. Upon making this comparison, Appellant has been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellant proceeds on the basis that the Examiner's sole response to Appellant's Amendment dated October 30, 2007 (hereinafter the Amendment) is found on pages 6-8 of the Fifth Office Action in the section entitled "Response to Arguments."

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness."² The legal conclusion of obviousness is based on underlying findings of fact including the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent arts.³ "Secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."⁴ Therefore, to properly make a finding of obviousness, a comparison between the applied prior art and the claims at issue must be made to ascertain the differences between what is being claimed and the teachings of the applied prior art. Moreover, before making a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed.⁵

The Examiner's analysis, however, lacks explicit claim constructions. Moreover, as noted in the in the first full paragraph on page 7 of the Amendment, the Examiner has failed to clearly designate the teachings in both Dziejima and Sokolov being relied upon the statement of the rejection as required by 37 C.F.R. § 1.104(c).⁶ Instead, the Examiner treats the claimed invention with a broad brush without considering the individual claimed elements. These deficiencies,

² In re Rijckaert, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

³ KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734 (2007).

⁴ Id. (quoting Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)).

⁵ See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994); see also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁶ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

however, were not cured in the Fifth Office Action. Therefore, the Examiner has failed to properly establish the facts underlying the Examiner's analysis. Appellant's position is that these omissions in the Examiner's prima facie analysis are correctable by the Examiner, and the correction of these omissions would help both Appellant and the Board gain a better understanding of the underlying facts and analysis employed by the Examiner in rejecting the claims. Thus, Appellant respectfully recommends that the Board remand the present application to the Examiner to address these omissions.⁷

On page 7 of the Amendment, Appellant presented the following arguments. The filing date of the present application is November 13, 2003, whereas the filing date of Dziejma is July 27, 2004. Therefore, the Examiner cannot rely upon the disclosure of Dziejma, but instead, the Examiner must be relying upon the disclosure in U.S. Provisional Application No. 60/490,590 (hereinafter the '590 provisional application), upon which Dziejma claims priority, since the filing date for the '590 provisional application is July 28, 2003, which is prior to the filing date of the present application. As stated in M.P.E.P. § 2136.03(III), entitled "PRIORITY FROM PROVISIONAL APPLICATION UNDER 35 U.S.C. 119(e)":

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a

⁷ The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. *E.g.*, *Ex parte Daleiden*, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); *Ex parte Rozzi*, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (McKelvey, J.) (remanding without decision because of a host of examiner omissions and procedural errors); *Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (BPAI 2001) (McKelvey, APJ) ("We decline to tell an examiner precisely how to set out a rejection."); *Ex parte Jones*, 62 USPQ2d 1206, 1208 (BPAI 2001) (McKelvey, APJ) (refusing to adjudicate an issue that the examiner has not developed); *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess."); *Ex parte Bracken*, 54 USPQ2d 1110, 1112-13 (BPAI 1999) (McKelvey, APJ) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph. (emphasis added)

Thus, the Examiner must establish that the '590 provisional application supports the subject matter being relied upon to make the rejection. This burden, however, has not been met.

The Examiner's response to these arguments is found in the last full paragraph on page 6 of the Sixth Office Action and is reproduced below:

The Examiner Respectfully Disagrees: The cited portion from the MPEP as cited in applicants remarks states "if the provisional application(s) properly supports the subject matter relied upon...." The examiner has already made that determination. It is unclear where in the MPEP it states that the burden is on the Examiner. In fact the use of Public PAIR gives applicant access to the provisional application and any subject matter disagreed upon should be specifically pointed out by the applicant. Since the provisional is already relied upon perhaps the provisional application number itself establishes the burden, since the entire provisional application "properly supports the subject matter". (emphasis in original)

As evident from the Examiner's comments, the Examiner does not appear to appreciate several fundamental aspects of patent law. First, as already noted above, the Examiner has the burden of establish a prima facie case of obviousness. Moreover, as already noted above, under 37 C.F.R. § 1.104(c), the Examiner must designate, as nearly as practicable, the particular part being relied upon in the rejection.

Another point not appreciated by the Examiner is that U.S. Patent Publication 2005/0028084 (hereinafter the '084 Publication) does not apply as prior art within the meaning of 35 U.S.C. § 102 (and thus § 103) since Appellant's present application has a filing date earlier than the filing date of '084 Publication. Therefore, the Examiner cannot rely upon the teachings of the '084 Publication.

Although the '084 Publication claims priority to a date of July 28, 2003, based upon U.S. Provisional Application No. 60/490,590 (hereinafter the '590 Provisional), this claiming of priority is not dispositive as to whether or not all the teachings found in the '084 Publication are found in the '590 Provisional. For example, a well-known fact is that many Applicants add additional subject matter to a provisional application prior to filing a non-provisional application. Thus, the subject matter that was in the non-provisional application may not be in the provisional application upon which the non-provisional application claims priority. Reference is also made to M.P.E.P. § 201.14(b), which states that "[t]he U.S. Patent and Trademark Office does not normally examine the papers to determine whether the applicant is in fact entitled to the right of priority and does not grant or refuse the right of priority." Thus, although a non-provisional application may claim priority, the non-provisional application may not be entitled to priority.

An issue very comparable to the present issue was recently decided in the non-precedential opinion of Ex parte Shimura.⁸ In this opinion, the Board ordered the Examiner to state "with respect to each and every claim element the Examiner asserts to be taught in [the non-provisional application] whether and where support for that teaching may be found in [the provisional application]. The Board also implied that the Examiner's discussion of the provisional application must "encompass all of the elements from [the non-provisional application] relied upon by the Examiner" (emphasis added).

Therefore, for the reasons stated above, the Examiner has not established a prima facie case of obviousness for failure, by the Examiner, to properly establish the underlying findings of

⁸ Appeal 2007-3036

fact regarding the scope and content of Dziejma and the differences between Dziejma and the claimed invention.

In the paragraph spanning pages 7 and 8 of the Amendment, Appellant noted that independent claim 1 was amended to include the limitations previously presented in claims 2-3 and 5; independent claim 6 was amended to include the limitations previously presented in claims 7 and 9; and independent claim 11 was amended to include the limitations previously presented in claims 12 and 14. However, upon reviewing the Examiner's analysis in the Fourth Office Action for dependent claims 2-3, 5, 7, 9, 12 and 14, it appears that the Examiner has "cut and paste" the same analysis regarding independent claims 1, 6, and 11 without ever addressing the limitations of the dependent claims. Thus, the Examiner failed to establish a prima facie case of obviousness regarding these claims.

So that the Board better understands the issue being raised by Appellant, the Board is invited to compare the paragraph spanning pages 3 and 4 of the Fourth Office Action (regarding claim 1) with the second full paragraph on page 4 of the Fourth Office Action (regarding claim 2) and the paragraph spanning pages 4 and 5 of the Fourth Office Action (regarding claim 3). Notably, all of these paragraphs are identical. With the exception of claim 15, the Examiner's "analysis" in the Fourth Office Action with regard to each of claims 1-14 is identical. This same paragraph was also used in rejecting claims 1, 6, and 11 within the Fifth Office Action.

The Examiner's response to Appellant's arguments in the Amendment are found in the second through fourth full paragraphs on page 7 of the Fifth Office Action. Initially, the Examiner asserted the following:

The Examiner Respectfully Disagrees: The claims have already been rejected and all claims include sections of the reference pertaining to the rejection. The Examiner infact has provided a detailed and logical explanation of the teachings of both references. Furthermore it has been cited in numerous actions that the teachings of a reference are not limited to specific portions, the reference as a whole must be considered by the applicant. Furthermore applicant fails to specifically point out or show how the reference as a whole fails to teach the claim limitations.

This Examiner's response is little more than an invitation to Appellant to guess as to how the Examiner is applying the prior art with regard to the specific limitations recited in the claims. As already noted, the Examiner's analysis employs a broad-brushed approach to the claims that ignores the specific language of the claims. As noted in the aforementioned Ex parte Schricker, Appellant should not be placed in a position to guess as to the basis of the Examiner's rejection.

The Examiner's second paragraph in responding to Appellant's arguments is reproduced below:

It is noted that any citation [(s)] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. ((Sec. MPEP 2123))

The "analysis" set forth in this paragraph is commonly found (and misused) within many actions from the Patent Office received by the real party in interest. This analysis has been used by many Examiners as an excuse to not specifically identify, within the applied prior art, the teachings being relied upon by the Examiner. Notwithstanding that "patents are relevant as prior art for all they contain,"⁹ the Examiner must still meet the requirements of 37 C.F.R. § 1.104(c) and establish the underlying findings of fact associated with making a prima facie case of obviousness. As already noted, these burdens have not been met.

⁹ See title of subsection (I) of M.P.E.P. § 2123.

The Examiner's second paragraph in responding to Appellant's arguments is reproduced below:

*It is **not necessary** that the references actually suggest, expressly or in so many words the changes or improvements that applicant has made. The test for combining references is what the references **as a whole** would have suggested to one of ordinary skill in the art. In re Shekler, 168 USPQ 716 (CCPA 1971); In re McLaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCPA 1968). (emphasis in original)*

The relevance of this case law to Appellant's arguments is unclear. The arguments to which the Examiner is responding involve the deficiency, in the Examiner's statement of the rejection, in identifying the specific elements of the dependent claims and setting forth the Examiner's analysis as to those specific elements (now incorporated into independent claims 1, 6, and 12). Thus, the Examiner's citations to case law are not relevant.

In the first full paragraph on page 8 of the Amendment, Appellant presented the following arguments. Notwithstanding the Examiner's failure to set forth any analysis regarding the dependent claims, the applied prior art fails to teach the limitations recited therein. Specifically, independent claims 1, 6, and 11 each include the concept that the functional calls are encapsulated within a validation shell of markup, which is illustrated in Fig 2 and described in paragraphs [0021] and [0022] of Appellant's disclosure. These features are neither taught nor suggested by the '590 provisional application.

These arguments were not addressed by the Examiner in the Fifth Office Action.

In the paragraph spanning pages 8 and 9 of the Amendment, Appellant further presented the following arguments. Appellant also disagrees with the Examiner's asserted rationale for modifying Dziejma in view of Sokolov. Specifically, the Examiner asserted the following in the paragraph spanning pages 3 and 4 of the Fourth Office Action:

Although Dziejma teaches the use of JavaScript in the FVE, he only shows function calls defined within the engine and fails to show reference to a separate library objects referenced by JavaScript. However Sokolov explicitly teaches the use of libraries which are interfaced with JavaScript (see abstract). Thus at the time of the invention it would have been obvious to the skilled artisan to have modified the script definitions of Dziejma to include reference to various JavaScript libraries has taught by Sokolov. The motivation for doing so would have been to provide extensibility to the validation engine by referencing libraries of scripting objects in JavaScript without constantly accessing a server, thus improving form validation on client devices. (emphasis added)

The problem allegedly solved by Sokolov is to provide extensibility to the validation engine without constantly accessing a server. However, Dziejma does not teach that the validation engine requires additional access to the server for extensibility. Instead, it appears that the validation engine of Dziejma, when originally received from the server, includes all the necessary functions and does not have to go back to the server (see paragraph [0012] of Dziejma). Thus, the problem allegedly solved by Sokolov is already addressed by Dziejma, and based upon common sense, one having ordinary skill in the art would not look to solve a problem that is already solved.¹⁰

The Examiner's response to these arguments is found in the paragraph spanning pages 7 and 8 of the Fifth Office Action and in the first two full paragraphs on page 8 of the Fifth Office Action. Initially, the Examiner asserted the following:

The Examiner Respectfully Disagrees: Based on common sense one of ordinary skill in the art would realize that the JavaScript library of Sokolov could be implemented with the JavaScript based form validation engine of Dziejma because it provides extensibility, specifically providing additional functions needed for form validation.

¹⁰ See the non-precedential opinion of *Ex parte Rinkevich*, Appeal 2007-1317 ("we conclude that a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill") (emphasis in original).

This "response" by the Examiner is not a true response since it completely ignores Appellant's arguments that the Examiner's alleged problem being solved by Sokolov is already addressed by Dziejma. Instead, the Examiner has simply rearranged the Examiner's previously-presented obviousness analysis. As such, not only has the Examiner not addressed Appellant's specific arguments, the Examiner has not even presented any new analysis.

The Examiner's second paragraph in responding to Appellant's arguments is reproduced below:

Further more as to the reason to combine not being the same as applicant's. **If it is obvious to combine references for one reason it is obvious to combine references for all reasons.** In re Graf, 145 USPQ 197 (CCPA 1965); In re Finsterwalder 168 USPQ 530 (USPQ 1970); In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976). In re Dillon, 892 F.2d 1544, 13 USPQ 1337 (1989); In re Dillon 919 F.2d 688, 16 USPQ 1897 Fed. Cir. 1990) (in bane) [sic] (emphasis in original)

Yet again, the Examiner presents case law having questionable applicability to the issue at hand or Appellant's prior arguments. Appellant has not presented any arguments as to the Examiner's rationale to combine "not being the same as applicant's." Instead, Appellant's arguments are directed to the common sense principle that one having ordinary skill in the art does not look to solve a problem that has already been solved.

The Examiner's third paragraph in responding to Appellant's arguments is reproduced below:

In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). (emphasis in original)

Once again, the Examiner presents case law having questionable applicability to the issue at hand or Appellant's prior arguments. Appellant has neither argued that the features of Sokolov cannot be bodily incorporated into Dziejma nor argued that the applied prior art must expressly suggest the claimed invention. Instead, Appellant has argued that the validation engine of Dziejma, when originally received from the server, includes all the necessary functions and does not have to go back to the server. As such, the problem allegedly solved by Sokolov is already addressed by Dziejma, and therefore, one having ordinary skill in the art, based upon common sense, would not have been realistically impelled to modify Dziejma in view of Sokolov.

Claim 15

On page 9 of the Amendment, Appellant presented the following arguments. Regarding claim 15, the Examiner relied upon Fig. 1 of Dziejma. Notwithstanding that Dziejma cannot be properly relied upon (instead, the Examiner must be relying upon the '590 provisional application to support the rejection), Dziejma does not teach using a pervasive device. Instead, Dziejma merely describes a server 410 and a client 420, which is not the disclosure of a pervasive device.

The Examiner's response to these arguments is found in the last full paragraph on page 8 of the Fifth Office Action and reproduced below:

The Examiner Respectfully Disagrees; It is unclear as to the precise meaning of a pervasive device since applicant fails to specifically show which portion of the specification explicitly describes "pervasive device". Furthermore the server client system is pervasive in the sense that a client device accessing a server is extremely common in the art. Finally it should be noted that all rejections are based on a combination of references and both teachings should be considered in detail, since Sokolov already describes the use of PDA's and wireless devices thus also encompassing pervasive devices (see column 1, lines 50-67 of Sokolov).

The Examiner's first statement with regard to the "precise meaning of a pervasive device" is disingenuous. In responding to rejections under the first and second paragraphs of 35 U.S.C. § 112 as to the term "pervasive device," Appellant presented arguments on pages 8 and 9 of the First Appeal Brief filed April 16, 2007. As noted by the present Examiner on page 2 of the Fourth Office Action, these arguments as to enablement and indefiniteness of the term "pervasive device" were persuasive.

For the Examiner to assert that "the server client system is pervasive in the sense that a client device accessing a server is extremely common in the art" evidences a failure, by the Examiner, to fully comprehend the breadth of the phrase "client" in a client-server system. A "client" can be almost any computing device, no matter how large, that is connected to a network a server. Thus, the generic teaching of a "client" does not specifically teach a pervasive device.

The Examiner's newly-presented citation to Sokolov notwithstanding, the Examiner's analysis is mostly based upon the teachings of Dziejma. Although a pervasive device can be employed using the teachings of Sokolov alone, the Examiner has failed to explain that it would have been obvious to employ a pervasive device based upon the teachings of Dziejma, as modified by Sokolov. As noted by Sokolov in the Examiner's cited passage, the memory footprint and computer resources in a pervasive device are at a premium, and "Java-based programs typically execute more and may have a larger memory footprint [than] native coded programs." Therefore, depending upon the specifics of the program, employing a Java-based program may not be desirable in a pervasive device.

Conclusion

Based upon the foregoing, Appellant respectfully submits that the Examiner's rejections under 35 U.S.C. §§ 101, 103 are not viable. Appellant, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. §§ 101, 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: April 25, 2008

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A lightweight pattern validation system for a client device receiving markup defining a form, comprising:

a validation processor separate from said markup and configured with a prototype interface for receiving both a field validation pattern and also form based input to be validated against said field validation pattern;

a validation script library within said client device and packaging said validation processor, wherein the form has at least one form based input field programmed for validation using said validation processor;

a library reference to said script library disposed in said markup;

a function call to said validation processor further disposed in said markup, said function call having a configuration for passing a reference to a value in said at least one form based input field for validation in said validation processor;

a plurality of additional function calls to said validation processor disposed in said markup, each additional one of said functional calls having a configuration for passing a reference to a value in a corresponding form based input field for validation in said validation processor; and

a validation shell function encapsulating said function calls.

6. A pattern validation method comprising the steps of:

retrieving a value for a form based input field from a form defined in markup rendered in a content browser;

passing said retrieved value along with a validation pattern for said form based input field to a validation process disposed within a lightweight validation library separate from and coupled to said rendered markup;

validating said retrieved value according to said validation pattern in said content browser;

repeating said retrieving, passing and validating steps for at least one additional value for at least one additional form based input field disposed in said markup rendered in said content browser; and

performing said retrieving, passing, validating and repeating steps in a validation shell function disposed in said markup rendered in said content browser.

11. A machine readable storage having stored thereon a computer program for pattern validation, the computer program comprising a routine set of instructions which when executed by the machine cause the machine to perform the steps of:

retrieving a value for a form based input field from a form defined in markup rendered in a content browser;

passing said retrieved value along with a validation pattern for said form based input field to a validation process disposed within a lightweight validation library separate from and coupled to said rendered markup;

validating said retrieved value according to said validation pattern in said content browser;

repeating said retrieving, passing and validating steps for at least one additional value for at least one additional form based input field disposed in said markup rendered in said content browser; and

performing said retrieving, passing, validating and repeating steps in a validation shell function disposed in said markup rendered in said content browser.

15. The system of claim 1, wherein the client device is a pervasive device.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.